

ATTORNEY DOCKET NO. 01153.0001U2
APPLICATION NO. 09/776,412

REMARKS

Claims 1-16 of the present application, U.S. Patent Application No. 09/776,412 (hereinafter "Application") stand rejected under 35 U.S.C. 102(e) as anticipated by U.S.P.N. 6,341,353 to Herman et al (hereinafter "Herman"). Claims 1-16 have been canceled and claims 17-40 are newly added by amendment. In view of Remarks, the Applicants respectfully assert that claims 17-40 of the Application are in a condition for allowance.

Rejections Under 35 U.S.C. §102(e)

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). For a process, anticipation requires identity of the claimed process and a process of the prior art. The claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). Those elements must either be inherent or disclosed expressly. *See, e.g., Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988). Those elements must also be arranged as in the claim. *See, e.g., Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). For anticipation, there must be no difference between the claimed invention and the reference disclosure as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Independent Claim 17

Claim 17 is newly added by amendment and contains steps from canceled claims 1 and 2. Accordingly, relevant rejections regarding claims 1 and 2 will be discussed with respect to claim 17. Claim 17 provides a method for providing an electronic receipt using an electronic receipt generator, and recites in relevant part:

A method for providing an electronic receipt using an electronic receipt generator, comprising the steps of:

generating by the electronic receipt generator an electronic receipt including detailed information describing the sales transaction,

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wherein the detailed information includes sale price, total transaction amount, item description, information indicating completion of the sales transaction, and a hyperlink associated with a product return procedure;

With respect to canceled claim 1, it was asserted that:

Re claims 1, 7, and 11, Herman teaches a method for providing an electronic receipt for facilitating product return (figs. 19 and 22), comprising the steps of:
generating an electronic receipt including information describing the product . . . and including a hyperlink having associated with it a product return procedure (col. 2, lines 11-14);

The cited language from Herman discloses, in context:

The Smart Receipt provides the customer with detailed information about an online purchase in a standardized format. Hyperlinks embedded in the Smart Receipt enable the customer to access customer service and order status. The merchant may also embed additional services within the Smart Receipt, including special offers for future purchases. Offers provided in a Smart Receipt can be personalized to a user's preferences which are stored on the Trusted Agent Server. Herman Col. 2, lines 9-17

The cited language from Herman discloses a Smart Receipt which enables a customer to access customer service, order status, or special offers for future services. In contrast, claim 17 recites the step of generating by the electronic receipt generator an electronic receipt including a hyperlink associated with a product return procedure. The Applicants respectfully assert that claim 17 is allowable for at least the reason that references to customer service, order status, or special offers do not disclose or suggest a step drawn to generating an electronic receipt by an electronic receipt generator with the electronic receipt including a hyperlink associated with a product return procedure.

Claim 17 includes steps whereby a buyer activates the hyperlink associated with the product return procedure, and, in response to hyperlink activation, recites steps for transmitting and displaying steps for returning the product to the seller.

Claim 17 states in relevant part:

- e. activating, by the buyer, the hyperlink on the computing device;
- f. transmitting, to the computing device and in response to activation of the hyperlink, return information containing steps for returning

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- the product; and
g. displaying the return information on the computing device.

Claim 2, now canceled, stated:

The method claimed in claim 1, further comprising the steps of:
a buyer activating the hyperlink using the computing device; and
in response to activation of the hyperlink, transmitting information
to the computing device including a presentation to the buyer via
the hypermedia user interface of steps for returning a product to
the seller.

With regard to canceled claim 2, the Office Action states:

Re claims 2 and 12, Herman teaches a buyer activating the
hyperlink using the computing device (Col. 2, lines 11-14); and in
response to activation of the hyperlink, transmitting information to
the computing device including a presentation to the buyer via the
hypermedia user interface of steps for returning a product to the
seller (fig. 22).

The cited language from Herman discloses, in context:

The Smart Receipt provides the customer with detailed information
about an online purchase in a standardized format. Hyperlinks
embedded in the Smart Receipt enable the customer to access
customer service and order status. The merchant may also embed
additional services within the Smart Receipt, including special
offers for future purchases. Offers provided in a Smart Receipt can
be personalized to a user's preferences which are stored on the
Trusted Agent Server. (Herman Col. 2, lines 9-17).

Figure 22, cited as disclosing limitations of canceled claim 2, discloses a logical
overview of the use of a Smart Receipt. Herman discloses with respect to Figure 22:

With respect to FIG. 22, the Smart Receipt 2201 is comprised of a
collection of LEDO objects. Each LEDO object has a unique
owner. Multiple owners exist within a chain of LEDO objects.
Here, the Smart Receipt 2201 comprises: an order object 2202
owned by the Buyer; a simple receipt object 2203 owned by the
merchant; a Smart Receipt object 2204 owned by the merchant; an
offer object 2205 owned by the manufacturer; and a customer
service object 2206 owned by the merchant. (Herman Col. 44,
lines 22 to 29).

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The Applicants respectfully assert that the activating, transmitting, and displaying steps of claim 17 are not disclosed or suggested by Herman. First, Herman does not disclose activating a hyperlink associated with a product return procedure as recited in step (e) of claim 17. Second, Herman nowhere discloses transmitting steps for returning a product in response to activating the hyperlink as recited in step (f) of claim 17. Third, Herman does not disclose displaying the steps for returning the product as recited in step (g) of claim 17. Thus, the Applicants respectfully assert that claim 17 is allowable for at least the reason that Herman does not disclose or suggest every step of claim 17.

Dependent Claim 18

Claim 18 depends from allowable independent claim 17 and contains steps similar to those in canceled claim 3. Accordingly, arguments regarding the allowability of claim 3 in the Office Action will be addressed in relation to claim 18.

Claim 18 states in relevant part:

- a. requesting, by the buyer, a return shipping label for the product pursuant to a step for returning the product;
- b. transmitting the return shipping label to the computing device; and
- c. producing a hard copy of the return shipping label using the computing device.

The Office Action states in relevant part:

Re claims 3 and 13, Herman teaches returning a product include: transmitting a return shipping label to the computing device and the buyer producing a hard copy of the return shipping label (col. 38, lines 8-24). Herman discloses a returning product includes either through a link to redemption at an online commerce site or by being printed on paper. (Emphasis added).

The cited language from Herman discloses:

The direct response server enables the creation, delivery, and single-click redemption of direct response offers from anywhere on the Internet. These offers can be delivered to trusted agents according to consumer preferences, or found in a banner-like format on Web sites. The direct response server can deliver online any one of at least three classic forms of traditional direct response. First, they can handle a direct order by concluding a transaction for the product they represent without requiring a jump to any other site.

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Second, they can generate a lead by transmitting a request to a merchant for additional information.

Third, they can generate store traffic, either through a link to redemption at an online commerce site, or by being printed on paper and taken for redemption to an actual retailer location. (Emphasis added).

Herman at Col. 8, lines 8-24 discloses the redemption of special offers based on consumer preferences delivered via a banner on a web site. The Applicants respectfully assert that the redemption of special offers via a web site banner does not disclose or suggest any of the steps of requesting, transmitting, and printing a return shipping label as recited in claim 18. The above cited language also discloses printing redemption offers and taking them to a retail location. The Applicants assert that printing redemption offers does not disclose the step of producing a hard copy of a return shipping label, nor disclose steps for requesting and transmitting a return shipping label as recited in claim 18.

The Applicants would like to draw the Examiner's attention to Herman at Col. 38, lines 25-39, which discloses:

The relationship marketing server uses smart receipts as the basis for after-market consumer care. When a consumer buys a product, the merchants relationship marketing server generates a unique digital object in the form of a smart receipt which contains all of the information needed for consumer care. The relationship marketing server sends this information to the customer's trusted agent. The customer can open his trusted agent using a URL, click on the smart receipt, and be presented with a number of services, such as automatically routed requests for customer service or return authorizations, 800 number listings to call for help, order status tracking (for example, offered in eventual partnership with such shipping companies as Federal Express or UPS), and pre-formatted and routed requests for related product offers. (Emphasis added).

Herman at Col. 38, lines 25-39 references requests for return authorizations. The Applicants assert that requests for return authorizations do not disclose or suggest any of the steps of requesting, transmitting, and producing a hard copy of a return shipping label as recited in claim 18. Thus, the Applicants respectfully assert that claim 18 is allowable for at least the reason that Herman does not disclose or suggest the steps of requesting, transmitting, and

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producing a hard copy of a return shipping label as recited in claim 18. Claim 18 is also allowable for at least the reason that it depends from allowable independent claim 17.

Dependent Claim 19

Claim 19 depends from independent claim 17, and contains steps similar to those in canceled claim 4. Accordingly, assertions regarding the allowability of claim 4 in the Office Action will be addressed in relation to claim 19.

With regard to canceled claim 4, the Office Action states:

Re claims 4 and 14, Herman teaches a buyer activating a hyperlink using the computing device (col. 4, lines 16-36; fig. 1); and in response to activation of the hyperlink, transmitting information to the computing device including a presentation to the buyer via the hypermedia user interface of steps for obtaining warranty service for a defective product (col. 37, lines 25-35).

Claim 19 states in relevant part:

- a. requesting, by the buyer, warranty service information pursuant to a step for returning the product;
- b. transmitting, to the computing device, steps for obtaining warranty service for the product; and
- c. displaying the steps for obtaining warranty service on the computing device.

The Office Action provides citations to Herman which purport to disclose the steps of requesting warranty service pursuant to a step for returning the product, transmitting the steps for obtaining warranty service for the product, and displaying the steps for obtaining warranty service as recited in claim 19.

Herman at Col. 4, lines 16-36 discloses:

End users 30 interact with one another and with game server 50 over a computer network (e.g., the Internet) 60 in a virtual world (e.g., an interactive environment governed by a prescribed set of rules) provided by game server 50 and supported by Transactor server 20. In this virtual world, digital property can be owned by, used, and transferred among end users. End users can also transfer digital property while offline (i.e., not in communication with the game or Transactor servers). Transactor server 20 communicates with Transactor broker 40 over the Internet 60 or, optionally, by a direct communications link.

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As illustrated in FIG. 2, other optional participants in the illustrated Transactor system include Transactor-enabled vendors (e.g., web sites) 70, a consumer's credit account holder 80, and a consumer's bank account 90. Transactor-enabled vendors preferably are accessible via the Internet 60, as are consumer's credit account holder 80 and consumer's bank account 90. The illustrated Transactor entities can be categorized broadly as clients and/or servers. Some entities may act as both a client and a server at the same time, but always as one or the other with regard to other specific entities. For example, a game server acts as a client to a Transactor server, but as a server to its game clients.

Herman at Col. 4, lines 16-36 discloses a game server and game clients. The Applicants assert that references to a game server and game clients do not disclose any step of claim 19.

Herman at Col. 37, lines 25-35 discloses:

The trusted agent server can be thought of as a third party that holds and manages the user's business affairs, such as a credit card, a product warranty, an insurance card, or any business contract. Users contact the server by way of a network access device, such as a browser on a personal computer, a browser on a network computer, a browser on a cell phone, or using a voice response unit on a telephone.

The trusted agent client is a small client program that augments the user's network access device to perform business transactions on behalf of the user. The user controls these transactions through the trusted agent server. (Emphasis added).

The Applicants would also like to reference Herman at Col. 39, lines 34-41, which discloses:

The customer understands that what they are manipulating is a familiar business instrument such as a credit card, a receipt, a coupon, a warranty, a contractual offer, a medical insurance card, or other well known commercial construct. It is simple to use a credit card number to charge goods and services to a credit card account without using the actual plastic card provided by the bank. The following definitions are applied to the different embodiments of these business instruments: (Emphasis added).

The above cited language from Herman contains the word warranty, and Herman additionally contains the word warranty or similar at Col. 44, line 9; Col. 44, lines 53; and Col. 45, lines 11-12. However, the Applicants respectfully assert that use of the word warranty in

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Herman does not disclose or suggest steps the steps of requesting, transmitting, and displaying steps for obtaining warranty service as recited in claim 19. Therefore, the Applicants respectfully assert that claim 19 is allowable for at least the reason that Herman does not disclose every step of claim 19. Claim 19 is also allowable for at least the reason that it depends from allowable claim 17.

Dependent Claim 20

The Applicants respectfully assert that claim 20 is allowable for at least the reason that Herman does not disclose steps for transmitting and producing a copy of a return shipping label as recited in claim 20. Claim 20 is also allowable for at least the reason that it depends from allowable claim 19.

Dependent Claim 21

Claim 21 depends from independent claim 17, and adds steps for requesting, transmitting, and displaying warranty text pursuant to a step for returning a product. As discussed above with respect to claim 19, Herman does not disclose the steps of requesting, transmitting, and displaying steps for obtaining warranty service as recited in claim 19. For the same reasons, Herman does not disclose steps for requesting, transmitting, and displaying warranty text as recited in claim 21. Thus, claim 21 is allowable for at least the reason that Herman does not disclose every step of claim 21. Claim 21 is also allowable for at least the reason that it depends from allowable independent claim 17.

Dependent Claim 22

Claim 22 depends from claim 17, and adds steps drawn to requesting, transmitting, and displaying product recall information pursuant to a step for returning a product. The Applicants respectfully assert that claim 22 is allowable for at least the reason that Herman does not disclose or suggest the steps of requesting, transmitting, and displaying product recall information as recited in claim 22. Claim 22 is also allowable for at least the reason that it depends from allowable independent claim 17.

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Dependent Claim 23

The Applicants respectfully assert that claim 23 is allowable for at least the reason that Herman does not disclose or suggest the steps of conducting a sales transaction between a buyer and a seller at a location associated with the seller, issuing a paper receipt to the buyer using a computing device operated by the seller, or transmitting information about the sales transaction over the Internet to the electronic receipt generator operated by a third party as recited in claim 23. Claim 23 is also allowable for at least the reason that it depends from allowable claim 17.

Independent Claim 24

Independent claim 24 combines steps from allowable claims 17-23, and so is allowable for at least one or more of the reasons given for the allowability of claims 17-23.

Dependent Claims 25-27

The Applicants respectfully assert that claims 25 and 26 are allowable for at least one or more of the reasons given for the allowability of claims 19 and 21. Claims 25 and 26 are also allowable for at least the reason that each depends from allowable claim 24.

Claim 27 further defines the conducting step of claim 24, and is allowable for at least the reason that Herman does not teach or disclose the steps of conducting a sales transaction between a buyer and a seller, issuing a paper receipt to the buyer using a computing device operated by the seller, and transmitting information about the sales transaction to the electronic receipt generator as recited in claim 27. Claim 27 is also allowable for at least the reason that it depends from allowable claim 24.

Independent Claim 28

Independent claim 28 combines steps from allowable claims 17-23, and so is allowable for at least one or more of the reasons given for the allowability of claims 17-23.

Dependent Claims 29-31

The Applicants respectfully assert that claims 29 and 30 are allowable for at least one or more of the reasons given for the allowability of claims 21 and 22. Claims 29 and 30 are also allowable for at least the reason that each depends from allowable claim 28. Claim 31 is

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allowable for at least the reasons given for the allowability of claim 27, and is also allowable for at least the reason that it depends from allowable claim 28.

Independent Claim 32

The Applicants respectfully assert that independent claim 32 is allowable for at least the reason that Herman does not teach or disclose the steps of conducting a sales transaction between a buyer and a seller, issuing a paper receipt to the buyer using a computing device operated by the seller, transmitting information about the sales transaction to the electronic receipt generator over a first network, generating the electronic receipt by the receipt generator, and sending the electronic receipt over a second network to a computing device operated by the buyer as recited in claim 32.

Dependent Claims 33-40

Claim 33 depends from claim 32 and is allowable for at least the reason that Herman does not disclose the method of claim 32 wherein the sales transaction is conducted at a location associated with the seller as recited in claim 33. Claim 34, which depends from claim 33, is allowable for at least the reason that Herman does not teach or disclose the method of claim 33 wherein the second network is a wireless network operating at the location associated with the seller as recited in claim 34. The Applicants also respectfully assert that claim 35, which depends from claim 32, is allowable for at least the reason that Herman does not teach the method of claim 32 wherein the sales transaction is conducted at a point of sale terminal associated with the seller as recited in claim 35. Claim 36 depends from claim 32 and is allowable for at least the reason that Herman does not teach the method of claim 32 wherein the receipt generator is operated by a third party as recited in claim 36. Claims 37-39 each depend from claim 32 and are allowable for at least the reason that Herman does not teach or disclose the method of claim 32 wherein the first and/or second networks are further defined as in claims 37-39. The Applicants also assert that claims 33-39 are allowable for at least the reason that each depends from an allowable claim.

The Applicants respectfully assert that claim 40, which depends from claim 32, is allowable for at least the reason that Herman does not disclose the steps of activating by the buyer the hyperlink on the computing device operated by the buyer, transmitting a return

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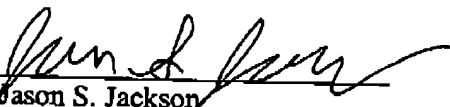
shipping label for the product to the buyer, and producing a hard copy of the return shipping label as recited in claim 40. Claim 40 is also allowable for at least the reason that it depends from an allowable claim.

CONCLUSION

In view of the above, each of the presently pending claims in the Application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass the Application to issue. If the Examiner believes discussion of any issue would expedite examination, the Examiner is encouraged to telephone the Applicant's undersigned representative. No additional fee is believed due. However, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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